REMARKS

No claims have been added or cancelled. Claims 1 and 16 have been amended. The claim amendment adds no new matter. Claim 15 was previously withdrawn under traverse. Claims 1-9, 11-18 and 20-22 are pending in the application.

The amendment of claims 1 and 16.

"A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." See MPEP §904 *et seq.* MPEP 706.07(a), pp. 700-73, Rev. 1, Feb. 2003. Claim 1 was amended to include a feature already present in its dependent claim 9. Claim 16 was amended to include a feature already present in its dependent claim 21. Under the above MPEP instruction, the amendments to claims 1 and 16 should not result in the next Office action being "final" if the next Office action includes a rejection on prior art not presently of record.

The objection to claim 1.

Claim 1 was objected to because it allegedly contained the word "qconsisting" in line 2 thereof. This typographic error was corrected in Applicant's FIRST SUPPLEMENTAL PRELIMINARY AMENDMENT filed on 3/27,2003. This objection is therefore obviated.

The teaching of the Gbur reference.

The Gbur reference discusses prior art, single layer, non-heat seal web materials at column 1, lines 9-27. The Gbur reference at column 1, line 28 to column 2, line 14 goes on to discuss disadvantages of these known, single layer, non-heat seal materials.

Ultimately, the Gbur reference at column 2, lines 15-16 explicitly states that "It is therefore an object of the present invention to obviate or mitigate the above mentioned disadvantages." As described in the Gbur reference from column 2, line 14 et seq., the

disadvantages of the previously discussed single layer, non-heat seal web materials are mitigated by providing an allegedly inventive web material having at least TWO layers, each having a specified composition. See, for example with bolding added, the Abstract: "A fibrous, porous web material . . . comprises a **first layer and a second layer** juxtaposed thereto . . ."; column 2, lines 16-22: "According to the first aspect of the present invention there is provided a fibrous, porous web material . . . comprising a **first layer and a second layer** juxtaposed thereto wherein the second layer has a smaller pore size then the first layer.": column 2, lines 28-29: "In the web material of the first aspect of the invention, the **second layer** has a smaller pore size than the **first layer**."; the EXAMPLE: "A paper . . . was prepared . . . by wet laying a **first (base) layer** of vegetable fibres combined with softwood **and a second (top) layer** of hardwood fibres which comprised 25% by weight of the total weight of the material." In fact, the Gbur reference at column 4, lines 2-3 explicitly teaches that the presence of a second layer of a smaller pore size is "an important feature" of the invention.

Thus, the Gbur reference fairly teaches that known, single layer, non-heat seal web materials are disadvantageous. There is no teaching or suggestion in the Gbur reference that this known, single layer, non-heat seal web material includes synthetic fibers. The Gbur reference strongly teaches away from their use and toward the use of multilayer non-heat seal web materials. There is NO teaching, suggestion or disclosure in the Gbur patent that the allegedly inventive web material can have less than TWO layers.

- **The Examiner's position as best understood.**

On pages 5-6 of the communication, the Examiner provides his position with respect to the Gbur disclosure. The Examiner states, with original bolding removed and bracketed text added:

> Gbur describes a fibrous, porous web material of the non-heat seal tissue having a basis weight of 9-18 g/square meter., (see abstract; column 1, lines 5-10) **[both citations describe inventive, multilayer, non-heat seal web materials]**. Gbur describes the non-heat seal paper

> is generally comprised of a single layer with a basis weight of 12.3 g/square meter, (column 2, lines 1-4) **[citation describes known, single layer, non-heat seal web materials]**. Gbur describes the non-heat seal paper is generally comprised of a single layer of vegetable fibers which does not incorporate fusible polymeric fibers, which does not exclude any synthetic non-fusible polymeric fibers, (column 1, lines 19-23) **[citation describes known, single layer, non-heat seal web materials]**. Gbur describes the fibers can have lengths of 0.8 mm. to 5 mm., (column 3, lines 40-44) **[citation describes inventive, multilayer, non-heat seal web materials]** Gbur implies that the weight of the vegetable fibers is about 90% by weight, (column 3, lines 27-28) **[citation describes inventive, multilayer, non-heat seal web materials]**, which implies that the synthetic fiber amount would be about 10% by weight which encompasses the claimed invention. It is the Examiner's position that Gbur describes the essential limitations of the claimed invention regarding a single layer. Nonwoven web is inherent in Gbur

The Examiner properly cites the Gbur text at column 2, lines 1-4 to show a teaching that it is known to provide a non-heat seal paper generally comprised of a single layer. However, the Examiner, if the above recited position is understood correctly, attempts to combine teachings within the alleged Gbur invention directed only to multilayer web materials with this prior art in an attempt to find the features of Applicant's claims. Contrary to this position there is no teaching, suggestion or disclosure that the allegedly inventive aspects of Gbur were, or can be, combined with the known, single layer, non-heat seal material disclosed therein. In fact, the Gbur reference explicitly teaches that the multilayer web material disclosed therein was an attempt to overcome disadvantages of the known, single layer, non-heat seal material.

As one example, the Examiner states: "Gbur describes fibers can have lengths of 0.8 mm to 5 mm, (column 3, lines 40-44)". In fact, column 3, lines 37-44 states, with bolding added:

> If desired, a proportion of the vegetable fibres of the first layer may be replaced by softwood fibres. Preferably the amount of softwood fibres does not exceed 75% by weight of the first layer. Softwood fibres are long, flat ribbon-like fibres which are readily distinguished by a person skilled in the art from vegetable fibres and hardwood fibres. **The softwood fibres may have a length of 0.8 mm to 5 mm** . . .

Thus, the cited fiber lengths refer to SOFTWOOD fibers that may be used in the TWO layer Gbur web material. The known, single layer, non-heat seal material disclosed in the Gbur patent is taught to be comprised of VEGETABLE fibers. (Gbur, column 1, lines 21-22) There is no disclosure that this known, single layer, non-heat seal material disclosed in the Gbur reference includes softwood fibers or other fibers having the length cited by the Examiner.

As another example, the Examiner asserts that: "Gbur implies that the weight of the vegetable fibers is about 90% by weight, (column 3, lines 27-28), which implies that the synthetic fiber amount would be about 10% by weight which encompasses the claimed invention." As discussed below, this teaching in actuality is limited to the TWO layer web material of Gbur wherein 50 to 90 % of the Gbur web material is provided by the vegetable fibers of the first layer and the remaining 10 to 50% of the web material weight is provided by the hardwood fibers of the second layer. There is no disclosure that the known, single layer, non-heat seal material disclosed in the Gbur reference includes synthetic fibers in any amount.

The Examiner also speculates concerning the fiber composition of the known, single layer, non-heat seal material discussed in the Gbur reference. The Gbur reference at column 1, lines 9-27 states:

> Infusion sachets for brewing beverages (e.g. so called teabags and coffee bags) are generally produced from either "heat seal" or "non-heat seal" fibrous porous web material (hereinafter also referred to as paper for convenience). Heat seal paper generally comprises two layers. One of these two layers includes fusible polymeric fibres which allow two layers of the paper to be heat sealed together in the production of infusion bags. The other layer is present as an insulation layer to prevent polymer (in the other layer) sticking to heated dies during conversion of the paper to produce an infusion sachet. In contrast, a non-heat seal paper (which normally has a basis weight in the range of 9 to 18 g m^{-2} and typically about 12.3 g m^{-2}) is generally comprised of a single layer comprised of vegetable fibres which does not incorporate fusible polymeric fibres. Thus, as its name suggests, non-heat seal paper cannot be heat sealed to itself. Infusion bags are produced from such paper by crimping or otherwise mechanically securing two layers of the paper together.

The Gbur reference teaches that heat seal material comprises two layers and that one of the layers includes fusible polymeric fibers. The Gbur reference distinguishes the previously described heat seal material from non-heat seal material by stating: "In contrast, a non-heat seal paper . . . is generally comprised of a single layer comprised of vegetable fibres which does not incorporate fusible polymeric fibres." Thus, the Gbur reference teaches only that known, single layer, non-heat seal material does NOT "incorporate fusible polymeric fibres". The Gbur reference does not teach, suggest or disclose that the known, single layer, non-heat seal material INCLUDES synthetic materials.

The Examiner correctly concludes that known, single layer, non-heat seal web material discussed in the Gbur reference does not include fusible fibers. Starting from this point, the Examiner goes on to correctly state that the single layer, non-heat seal material discussed in the Gbur reference does not explicitly "exclude any synthetic non-fusible polymeric fibers". The Examiner than leaps to the conclusion that since the single layer, non-heat seal material discussed in the Gbur reference does not explicitly "exclude any synthetic non-fusible polymeric fibers", it must include synthetic fibers. The only apparent support for this leap is a citation to Gbur, column 3, lines 27-28. As discussed in more detail, that cited text of Gbur 1) discloses vegetable fiber concentrations in the first layer of a two layer web, 2) does not refer to, or suggest that, the known single layer non-heat seal material uses similar fiber concentrations and 3) does not imply anything concerning synthetic fiber concentrations as the remaining material of the web is the hardwood fiber of the second layer.

The rejection of claims 1-4, 6, 9, 11 and 16-18 under 35 U.S.C. §102(b).

Claims 1-4, 6, 9, 11 and 16-18 were rejected under 35 U.S.C. §102(e) as allegedly having each and every feature and interrelationship anticipated by U.S. Patent No. 6,139,883 to Gbur et al.

"It is elementary that an anticipation rejection requires a showing that each

limitation of a claim must be found in a single reference, practice, or device." In re Donohue, 226 USPQ 619, 621 point 2 (Fed. Cir. 1985). Further, to be prior art under 35 U.S.C. §102 a reference must contain an enabling disclosure of the invention. Chester v. Miller, 15 USPQ2d 1333, 1336 note 2 (Fed. Cir. 1990).

- **Claim 1 is not anticipated by the Gbur reference.**

  Claim 1 recites:

  > A fibrous non-woven non-heat seal porous web material consisting of a single, wet laid layer and comprising a substantially homogeneous mixture of 0.5 to 25 percent by weight of synthetic material with natural fibers comprising the remainder of said web material.

The Gbur reference from column 1, line 9 to column 2, line 14 describes known paper products. Column 1, lines 9-27 states, with underlining added:

> Infusion sachets for brewing beverages (e.g. so called teabags and coffee bags) are generally produced from either "heat seal" or "non-heat seal" fibrous porous web material (hereinafter also referred to as paper for convenience). Heat seal paper generally comprises two layers. One of these two layers includes fusible polymeric fibres which allow two layers of the paper to be heat sealed together in the production of infusion bags. The other layer is present as an insulation layer to prevent polymer (in the other layer) sticking to heated dies during conversion of the paper to produce an infusion sachet. In contrast, a non-heat seal paper (which normally has a basis weight in the range of 9 to 18 g m^{-2} and typically about 12.3 g m^{-2}) is generally comprised of a single layer comprised of vegetable fibres which does not incorporate fusible polymeric fibres. Thus, as its name suggests, non-heat seal paper cannot be heat sealed to itself. Infusion bags are produced from such paper by crimping or otherwise mechanically securing two layers of the paper together.

Thus, the Gbur reference explicitly teaches that known, TWO layer, HEAT SEAL products may include fusible polymeric fibers. The Gbur reference explicitly teaches that known, single layer, non-heat seal paper does NOT incorporate fusible polymeric fibers. The "showing that each limitation of a claim must be found in a single reference" required for a legally supportable anticipation rejection is missing as the Gbur reference

does NOT teach, suggest or disclose that a single layer web material CONTAINS synthetic material. Claim 1, and claims dependent therefrom, are patentable for at least this reason.

Further, the Gbur discussion of known, single layer, non-heat seal material does not disclose the use of synthetic materials in that material or the preparation of that single layer, non-heat seal material from a mixture comprising synthetic materials. Thus, the Gbur reference contains NO enabling disclosure of the use of synthetic materials in a single layer, non-heat seal web material. Under the Chester v. Miller precedent, the Gbur reference is not legally prior art with respect to anticipation of Applicant's claims. Claim 1, and claims dependent therefrom, are patentable for at least this additional reason.

Alternatively, it may be that the Examiner is asserting that polymeric materials are inherently present in the known single layer non-heat seal web material described in Gbur. The courts, addressing the doctrine of inherency, have stated: "The doctrine of inherency is available only when the prior inherent event can be established as a certainty. That an event may result from a given set of circumstances is not sufficient to establish anticipation. Probabilities are not sufficient . . . A prior inherent event cannot be established based upon speculation or where a doubt exists." Ethyl Molded Products Co. v. Betts Package Inc., 9 USPQ2d 1001, 1032-1033 (E.D. Ky. 1988). The Board, has also addressed the doctrine of inherency. To rely on the theory of inherency in rejecting a claim under 35 U.S.C. 102 or 103, " . . . the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Under this theory there is still NO enabling disclosure of the use of synthetic materials in a single layer, non-heat seal web material and therefore under the Chester v. Miller precedent, the Gbur reference is not legally prior art with respect to anticipation of Applicant's claims. Further, there is no fact or technical reason as to why the prior art non-heat seal web material disclosed in the Gbur reference MUST NECESSARILY

contain synthetic materials. Claim 1, and claims dependent therefrom, are not inherently anticipated by the cited references and are patentable for at least this reason.

- **Claim 2 is not anticipated by the Gbur reference for additional reasons.**

Claim 2 recites: "The web material of claim 1, comprising 1 to 10 percent by weight synthetic material." Claim 2 depends directly from claim 1, so that claim 2 is also directed to a web material "consisting of a single, wet laid layer".

The Examiner asserts, with bolding added: "Gbur **implies** that the weight of the vegetable fibers is about 90% by weight, (column 3, lines 27-28), which **implies** that the synthetic fiber amount would be about 10% by weight which encompasses the claimed invention."

The Gbur reference at column 3, lines 13-15 states, with bolding added: "The **hardwood** fibres of the **second layer** may for example comprise **10% to 50%**, preferably 20% to 40%, **by weight of the total weight of the web material**." The Gbur reference at column 3, lines 27-36 (encompassing the text cited by the Examiner) states, with bolding added

> Preferably the **vegetable** fibres **of the first layer** provide **50% to 90%**, more preferably 50% to 70%, **by weight of the web material**. These fibres will generally have a length of 0.8 mm to 9 mm and may for example have a mean length of about 4.3 mm. A suitable vegetable fibre is Manila (Abaca).

Thus, when the entire relevant Gbur disclosure is read, it becomes clear that the text cited by the Examiner explicitly teaches a TWO layer web material and NOT the single layer web material recited in Applicant's claims.

Further, the cited text of the Gbur reference explicitly teaches that 50 to 90% of the Gbur web material weight is provided by the vegetable fibers of the first layer and the remaining 10 to 50% of the web material weight is provided by the hardwood fibers of the second layer., Contrary to the Examiner's speculations, the cited text of Gbur does not teach, suggest or imply the presence of 0.5 percent to 25 percent of synthetic materials in a single layer, non-heat seal web material.

With respect to the known, single layer, non-heat seal material discussed in column 1 of the Gbur reference, the Gbur text cited by the Examiner is properly limited to the multilayer Gbur web material. There is no teaching or suggestion that this cited text has any relationship to the known, single layer, non-heat seal material disclosed in column 1 of Gbur. In fact, as discussed above it is an object of the Gbur multilayer web material to obviate or mitigate the above mentioned disadvantages of such prior art non-heat seal papers. Applicant's web material consisting of a single wet laid layer including synthetic material is not taught or suggested by the Gbur reference. Applicant respectfully traverses the Examiner's assertion. Claim 2 is not anticipated by the Gbur reference for at least this additional reason.

- **Claim 6 is not anticipated by the Gbur reference for additional reasons.**

Claim 6 recites in part: "The web material of claim 1, wherein the synthetic material comprises synthetic pulp having a micro-fibrillar structure . . ." Synthetic pulp materials are described in Applicant's specification at page 6, line 14 to page 7, line 23. The Examiner has NOT indicated where the Gbur reference teaches use of a "synthetic pulp having a micro-fibrillar structure" as recited in claim 6 and described in Applicant's specification. Applicant respectfully traverses this rejection. Claim 6 is not anticipated by the Gbur reference for at least this additional reason.

- **Claim 16 is not anticipated by the Gbur reference for additional reasons.**

Claim 16 recites in one pertinent part: "A process of making a fibrous non-woven non-heat seal porous web material of enhanced dry crimp strength comprising: forming a slurry of natural fibers; adding synthetic materials to said slurry to form a furnish; wet laying said furnish to form a single layer web; . . ."

The Examiner has not indicated where the Gbur reference teaches a process of making a web material of enhanced dry crimp strength. Additionally, the Examiner has not indicated where the Gbur reference teaches wet laying a furnish comprising synthetic material to form a single layer web material. Applicant respectfully traverses

this rejection. Claim 16, and claims dependent therefrom, are not anticipated by the Gbur reference for at least these additional reasons.

- **Claims 17 and 18 are not anticipated by the Gbur reference for additional reasons.**

Claim 17 recites in one pertinent part: "wherein said web material comprises 0.5 to 25 percent synthetic materials." The Examiner asserted that the Gbur reference implicitly disclosed the presence of 10% synthetic fibers. As discussed above, the text referred to by the Examiner in actuality discloses only that 50 to 90 % of the Gbur web material is provided by the vegetable fibers of the first layer and the remaining 10 to 50% of the web material weight is provided by the hardwood fibers of the second layer. Applicant respectfully traverses this rejection. Claim 17 is not anticipated by the Gbur reference for at least these additional reasons. Claim 18 recites similar limitations and is not anticipated by the Gbur reference for similar reasons.

The rejection of claims 1, 5, 7-8, 12-14 and 20-22 under 35 U.S.C. §103(a).

Claims 1, 5, 7-8, 12-14 and 20-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,139,883 to Gbur et al in view of U.S. Patent No. 5,431,997 to Scott et al or U.S. Patent No. 2,414,833 to Osborne.

- **Claims 20-21 depend from non-rejected claim 16 and are therefore patentable.**

Claim 16 is an independent claim that was NOT rejected as being unpatentable over U.S. Patent No. 6,139,883 to Gbur et al in view of U.S. Patent No. 5,431,997 to Scott et al or U.S. Patent No. 2,414,833 to Osborne. Therefore, claim 16 IS patentable over U.S. Patent No. 6,139,883 to Gbur et al in view of U.S. Patent No. 5,431,997 to Scott et al or U.S. Patent No. 2,414,833 to Osborne.

Claims 20 and 21 each depend directly from claim 16. Since independent claim 16 is patentable, claims 20 and 21, each directly dependent from claim 16, must also be

patentable. Applicant respectfully traverses this rejection of claims 20 and 21 and asserts that they are patentable.

- **The rejection of claims 1, 5, 7-8, 12-14 and 20-22.**

As stated in MPEP §2143, to establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

- **The prior art references do NOT teach or suggest all the claim limitations.**

As discussed above, claim 1 is directed to a web material "consisting of a single, wet laid layer". Employing the fibers of the Scott or Osborne references in the inventive multilayer web material of Gbur still yields a multilayer web material. Applicant's single layer web material is not taught or suggested by the Examiner's combination.

Further, as stated by the Court in Symbol Technologies Inc. v. Opticon Inc., 935 F.2d 1569, 1578; 19 USPQ2d 1241, 1247 (Fed. Cir. 1991), a non-enabling reference may qualify as prior art for the purposes of determining obviousness under 35 U.S.C. §103, but only for what is disclosed in that reference. There is NO disclosure in the Gbur reference that the known, single layer, non-heat seal material contained any synthetic fibers. Thus, if the Examiner is relying on the discussion in the Gbur reference of single layer, non-heat seal material to combine with the Scott or Osborne references, such reliance is misplaced. Claim 1, and claims dependent therefrom, are not *prima facie* obvious over the cited references and are patentable for at least these reasons. Claims 16 and 22 contain similar limitations so that claims 16 and 22, and claims dependent therefrom, are not *prima facie* obvious over the cited references and are patentable for at least these reasons.

- **Claim 5 is patentable for additional reasons.**

Claim 5 recites: "The web material of claim 1, wherein the synthetic material is not fully thermally activated." Activation of synthetic materials is described in Applicant's specification at page 9, line 25 to page 10, line 26. The Examiner has NOT indicated where any of the cited references teach or suggest the use of synthetic material that is not fully activated. Claim 5 is not obvious over the cited references and is patentable for at least this additional reason.

- **Claim 7 is patentable for additional reasons.**

Claim 7 recites: "The web material of claim 6, wherein the synthetic pulp consists of a polyolefin material." Synthetic pulp materials are described in Applicant's specification at page 6, line 14 to page 7, line 23. The Examiner has NOT indicated where any of the cited references teach or suggest the use of synthetic pulp as described in Applicant's specification. Claim 7 is not obvious over the cited references and is patentable for at least this additional reason.

- **Claim 12 is patentable for additional reasons.**

Claim 12 recites: "The web material of claim 1 having a dry crimp strength at least twenty percent greater than a fibrous non-woven non-heat seal porous web material consisting of the same fibers but without the synthetic material." The Examiner has NOT indicated where any of the cited references teach or suggest the a web material having a dry crimp strength at least twenty percent greater than a fibrous non-woven non-heat seal porous web material consisting of the same fibers but without the synthetic material. Claim 12 is not obvious over the cited references and is patentable for at least this additional reason.

- **Claim 22 is patentable for additional reasons.**

Claim 22 recites in one pertinent part: "th e web material comprises a

substantially homogeneous mixture of about 0.5 percent to about 25 percent by weight of synthetic material selected from polyethylene, polypropylene, polyester and mixtures thereof . . ." As discussed above, the Gbur reference discloses only that 50 to 90 % of the Gbur web material is provided by the vegetable fibers of the first layer and the remaining 10 to 50% of the web material weight is provided by the hardwood fibers of the second layer. Applicant respectfully traverses this rejection. Claim 22 is not anticipated by the Gbur reference for at least this additional reason.

- **There is no suggestion or motivation to combine the Gbur and Osborne references.**

The Examiner asserts, with underlining added:

> It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the synthetic materials of Scott or Osborne for the man made fibers of Gbur motivated with the expectation that <u>these synthetic materials of Scott or Osborne</u> would function equivalently to enhance the properties of diffusion of the web material because of <u>their light weight</u> as noted by Scott, (column 3, lines 23-38).

As best understood by Applicant, "their light weight" in the above quote refers to "these synthetic materials of Scott or Osborne". It appears that the Examiner is asserting that the combinations are obvious because the synthetic materials of Scott or Osborne are "light weight" and this "light weight" property enhances the properties of diffusion.

Column 3, lines 21-38 of the Scott reference states, with bolding added:

> The present invention in its application to tea bags permits the use of commercially available, self-supporting infuser webs. **These webs are** generally soft, tissue-thin fibrous materials **characterized by light weight** but, when used as described hereinbefore, possess the disadvantage of somewhat limited seam integrity in boiling water. The webs are of the nonheat-seal variety and require mechanical fastening, i.e., folding and crimping, for the formation of the tea bag. Typical are the loosely formed, low density papers made of long natural fibers as described in Osborne

U.S. Pat. Nos. 2,045,095 and 2,045,096.

As can be seen from the above text, "light weight" refers to the web material and NOT the fibers as asserted by the Examiner. Thus, the Examiner's asserted reason for making the combination is not valid for at least this reason.

Additionally, The Examiner asserts that the "light weight" property of the fibers enhances the properties of diffusion. As discussed in the Osborne patent at column 1, line 50 to column 2, line 4 states, with bolding added:

> The paper produced in accordance with the foregoing procedure has, as has been previously pointed out, utility as a filtering paper in the manufacture of teabags. It is made up of extremely long fibers . . . loosely formed into a very low density paper having many interstices or opening between the fibers. **These openings permit the rapid passage of liquids therethrough** . . .

Thus, contrary to the Examiner's reasoning, it is NOT the "lightweight" property of the fibers but the openings in the paper that enhance diffusion. The Examiner's asserted reason for making the combination is not valid for at least this additional reason. Claims 1, 5, 7-8, 12-14 and 20-22 are not *prima facie* obvious over the cited combination of Gbur and Osborne and are patentable for at least this additional reason.

- **The Gbur reference teaches away from combination with the Osborne reference.**

A reference that teaches away from a claimed invention does not provide the suggestion or motivation needed to anticipate or make obvious a claimed invention. In fact, the courts have stated that a reference that teaches away from a claimed invention is an indication of the nonobviousness of that invention. "A reference, however, must have been considered for all it taught, disclosures that diverged and taught away from the invention at hand as well as disclosures that pointed towards and taught the invention at hand." Ashland Oil, Inc. v. Delta resins & Refractories, Inc., 227 USPQ 657, 666 (Fed. Cir. 1985). "One important indicium of nonobviousness is 'teaching away' from the claimed invention by the prior art." In re Braat, 16 USPQ2d 1813, 1814

(Fed. Cir. 1990). The prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. See MPEP §2141.02.

- The Gbur reference is directed to a NON-HEATSEAL web material while the Osborne reference is directed to a HEATSEAL web material. As discussed in the Gbur reference at column 1, line 9-27, (also cited by the Examiner), these two types of materials are considered to be mutually exclusive in the art.
- The Gbur reference teaches a web material having a hardwood face and an opposing vegetable face. The Osborne reference requires one face of the web material to be of a thermoplastic material to retain the heat seal property.

Given these differences the Gbur and Osborne references can fairly be said to teach away from each other. Claims 1, 5, 7-8, 12-14 and 20-22 are not *prima facie* obvious over the cited combination of Gbur and Osborne and are patentable for at least this additional reason.

- **There is no suggestion or motivation to combine the Gbur and Scott references.**

The Examiner asserts that: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the synthetic materials of Scott or Osborne for the man made fibers of Gbur motivated with the expectation that these synthetic materials of Scott or Osborne would function equivalently to enhance the properties of diffusion of the web material because of their light weight as noted by Scott, (column 3, lines 23-38)."

As discussed above the Examiner's asserted reason for making the combination is not supported by his cited references. Claims 1, 5, 7-8, 12-14 and 20-22 are not *prima facie* obvious over the cited combination of Gbur and Scott and are patentable for at least these reasons.

- **The Gbur reference teaches away from combination with the Scott reference.**

As discussed above, a reference that teaches away from a claimed invention does not provide the suggestion or motivation needed to anticipate or make obvious a claimed invention. In fact, the courts have stated that a reference that teaches away from a claimed invention is an indication of the nonobviousness of that invention.

The Gbur reference is directed only to a MULTILAYER web material. This multilayer web material was taught to be an improvement over known single layer non-heat seal web material. The Scott reference appears to disclose only conventional SINGLE layer web materials that have been impregnated with a hydrophobic treating system. Given these differences the Gbur and Scott references can fairly be said to teach away from each other. Claims 1, 5, 7-8, 12-14 and 20-22 are not obvious over the cited combination of Gbur and Osborne and are patentable for at least this additional reason.

Space intentionally blank.

In summary, Applicant has addressed each of the objections and rejections within the present Office Action. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is respectfully solicited.

The Examiner is invited to telephone Applicant's attorney if it is deemed that a telephone conversation will hasten prosecution of this application.

Respectfully submitted,

Helen Viazmensky et al

By: _____
James E. Piotrowski
Registration No. 43,860
Alix, Yale & Ristas, LLP
Attorney for Applicants

Date: 7/10/2003
750 Main Street- Suite 1400
Hartford, CT 06103-2721
(860) 527-9211

G:\1wpdocs\Jep\Dexter\dexnon 096\dexnon 096 us 7-03 response as filed.doc